



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,407	01/25/2002	Alain Corbier	146.1376	5822

7590 01/10/2005

Charles A Muserlian  
Bierman Muserlian and Lucas  
600 Third Avenue  
New York, NY 10016

EXAMINER

SHIAO, REI TSANG

ART UNIT PAPER NUMBER

1626

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)	
	10/009,407	CORBIER ET AL.	
	Examiner	Art Unit	
	Robert Shiao	1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on responses filed on 09/30, 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This application claims priority of the foreign application: FRANCE 99/07252 with a filing date 06/09/1999. However, a certified copy of the English-translated version of the foreign priority document has not been filed. Therefore, the foreign priority is not granted.
2. Cancellation of claims 17-19 in the preliminary amendment filed on 07/31, 2003, is acknowledged. Claims 1-16, and 20-23 are pending in the application.

### ***Responses to Election/Restrictions***

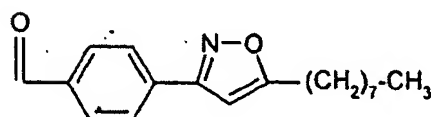
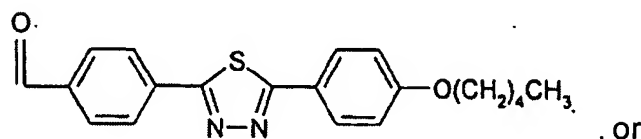
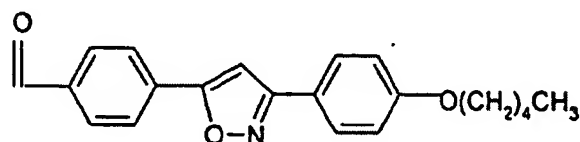
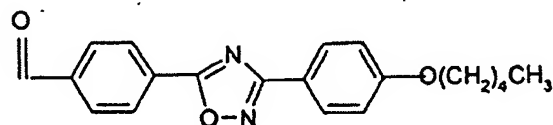
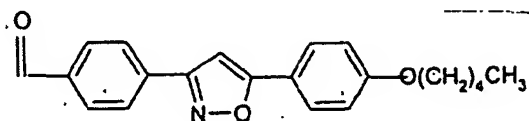
3. Applicant's election with traverse of Group I claims 1-23 (now are 1-16, and 20-23), in part, in the reply filed on September 30, 2004, is acknowledged. The traversal is on the grounds that the Examiner has failed to specifically describe the unique special feature in each group. This is not found persuasive, and the reasons are given, *infra*.

### ***Status of the Claims***

4. Claims 1-16, and 20-23 are pending in the application. The scope of the invention of the elected subject matter is as follows:

Claims 1-16, and 20-23, in part, drawn to compounds/compositions of formula (I), wherein the variables  $R_1$  and  $R_2$  independently do not represent heterocycle, and the variables  $R_1$  and  $R_2$  independently are not substituted with heterocycle thereof (i.e., variables a, b, a', b', e, or f with the nitrogen do not form heterocycle); the variables  $R_3$ ,  $R_4$ , T, Y, W and Z are as defined in claim 1; the variable R independently represents

Art Unit: 1626



thereof, and their methods of use.

The above mentioned withdrawn compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups (i.e., aryl, heteroaryl or heterocycle of the variable R) which differ from those of the elected invention such as oxazole of Group I, diazole of Group II, pyridine of Group II, sulfonylphenyl of Group III, piperazine or morpholine of Group IV, etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e., class 548 subclass 215(+) (oxazole), class 548 subclass 300.1(+) (diazole), class 546 subclass 249 (+)

Art Unit: 1626

(pyridine), class 568 subclass 27 (+) (sulfonylphenyl), class 544 subclass 358(+) (piperazine), class 544 subclass 106(+) (morpholine), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly.

The Markush group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

Since the newly added claims are commensurate with the scope of the invention, therefore, the invention claims, 1-16, and 20-23, in part, embraced in above elected subject matter, are prosecuted in the case. Claims 1-16, and 20-23, in part, not embraced in above elected subject matter, are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made **FINAL**.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1626

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16, and 20-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. It is noted that the claims contains subject matter "all possible isomeric forms", which were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, i.e., see claim 1, line 2, or claim 14, page 9, line 8.

6. Claims 1-16, and 20-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for isomers A or B of the compound of formula (I), does not reasonably provide enablement other than isomers A or B of the compound of formula (I), see pages 10-17. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

For rejections under 35 U.S.C. 112, first paragraph, the following factors must be considered (In re Wands, 8 USPQ2d 1400, 1988):

- 1) Nature of invention.
- 2) State of prior art.

- 3) Level of ordinary skill in the art.
- 4) Level of predictability in the art.
- 5) Amount of direction and guidance provided by the inventor.
- 6) Existence of working examples.
- 7) Breadth of claims.
- 8) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

See below:

1) Nature of the invention

The claims are drawn to all possible isomers form of the compound of formula (I) without limitation.

2) State of the prior art

The reference Giacobbe et al. US 4,968,608 does not indicate which compounds of instant compounds may be useful in the claimed invention. Giacobbe et al. '608 is pertaining to process for antifungal fermentation product.

3) Level of ordinary skill in the art.

The level of ordinary skill in the art is high. The claims are drawn to "all possible isomers form of the compound of formula (I) without limitation". Applicant's specification does not enable the public to prepare such "all possible isomers form of the compound of formula (I) without limitation" by the instant examples disclosed in the specification.

4) Level of predictability in the art.

The claims are drawn to "all possible isomers form of the compound of formula (I) without limitation", see claim 1, line 2, or claim 14, page 9, line 8.

Art Unit: 1626

Different types of the genus of methods require various experimental procedures and without guidance that is applicable to all possible “all possible isomers form of the compound of formula (I) without limitation”, there would be little predictability in the scope of claimed isomers of the compound of formula (I).

5) Amount of direction and guidance provided by the inventor.

The claims are drawn to “all possible isomers form of the compound of formula (I) without limitation”, encompasses a vast number of compounds.

Applicant's limited guidance does not enable the public to prepare such “all possible isomers form of the compound of formula (I) without limitation” in the specification. There is no enablement for “all possible isomers form of the compound of formula (I) without limitation”, i.e., isomers of the compound of formula (I) are other than isomers A or B, which are neither enabled nor supported in the specification.

6) Existence of working examples.

The claims are drawn to “all possible isomers form of the compound of formula (I) without limitation”, encompasses a vast number of methods.

Applicant's limited working examples do not enable the public to prepare such a numerous amount of “all possible isomers form of the compound of formula (I) without limitation” in the specification. Applicants claim “all possible isomers form of the compound of formula (I) without limitation”, however, the specification provides only limited examples of the methods.

7) Breadth of claims.

The claims are extremely broad due to the vast number of possible “all



Art Unit: 1626

possible isomers form of the compound of formula (I) without limitation".

8) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The specification did not enable any person skilled in the art to which it pertains to make or use the invention commensurate in scope with this claim. In particular, the specification failed to enable the skilled artisan to practice the invention without undue experimentation. The skilled artisan would have a numerous methods in order to obtain "all possible isomers form of the compound of formula (I) without limitation" as claimed. Based on the unpredictable nature of the invention and state of the prior art and the extreme breadth of the claims, one skilled in the art could not perform the claimed compounds without undue experimentation, see *In re Armbruster* 185 USPQ 152 CCPA 1975. Incorporation of the limitation of "all possible isomers form of the compound of formula (I) without limitation", i.e., isomers A or B, see pages 10-17 of the specification.

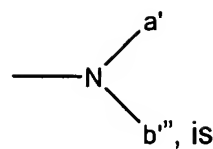
7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

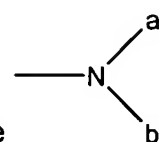
Claims 1-16 and 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1626

Claim 1, page 3, line 4-5, recites the limitation "and

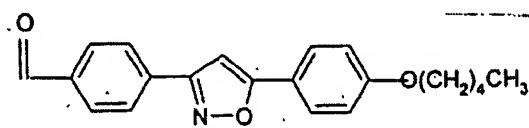


ambiguous and indefinite. It is unclear which variables have the moiety. Is it the variable  $R^2$  or  $X$ ? Clarification is required, see page 2-3 of the specification.



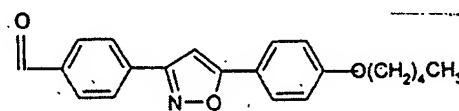
Claim 1, page 3, line 16, recites the limitation "R is selected from the

group consisting of



, is ambiguous and

indefinite. It is unclear which moiety of the



is

linked to the  $-NH-$  moiety of the compound of formula (I). Is it the  $C=O$  or the



moiety? Clarification is required, see pages 10-13 of the specification.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

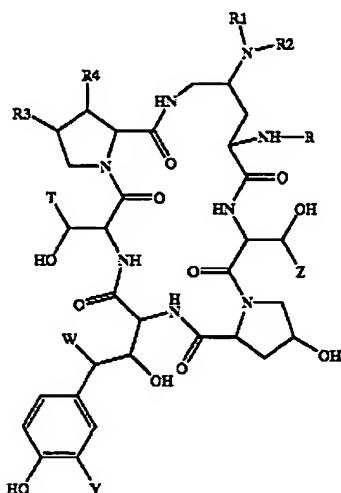
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1626

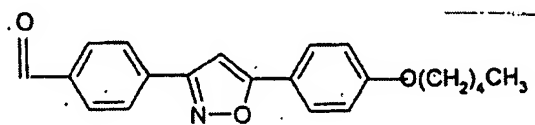
Claims 1-16 and 20-23 are rejected under 35 U.S.C. 102(a) as being anticipated by Courtin et al. WO 99/29716 or US 6,677,429.

Applicants claim a compound of formula (I) as agents for treating fungal infection, and the compounds are found on the page 1-17 of the specification.

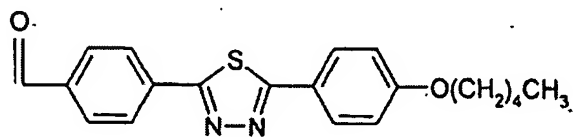
Courtin et al. disclose a compound of formula (I) as agent treating fungal



Infection, , wherein variables  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $T$ ,  $W$ ,  $Y$ , and  $Z$  independently represents hydrogen, hydroxy, alkyl, cycloalkyl,



and the variable  $R$  represents , or

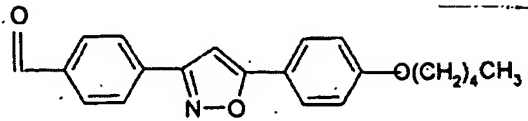


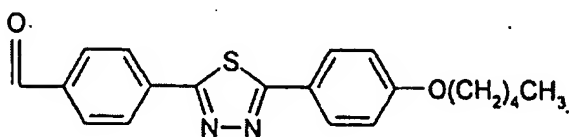
, see columns 17-19 of Courtin et al. '429.

Courtin et al. compounds clearly anticipate the c instant compounds of formula (I), wherein the variables  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $T$ ,  $W$ ,  $Y$ , and  $Z$  independently

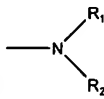
Art Unit: 1626

represents hydrogen, hydroxy, alkyl, cycloalkyl, and

the variable R represents , or



Courtin et al. disclose a process of preparing a compound of formula (I) comprising steps (i) a compound of formula (III) reacts with an agent capable of replacing  $\text{-NH}_2$  by  $\text{-NHR}$ , to obtain a compound of formula (IV); (ii) a compound of formula (IV) reacts with trimethylsilyl iodide to obtain a compound of formula (II); (iii) a compound of formula (II) reacts with amine or an amine derivative in

the presence of a reducing agent to induce  to obtain a compound of formula (I). Courtin et al. processes clearly anticipate the instant processes (i.e., claims 14-16, and 21) using same starting materials compounds of formula (II), (III), (IV), trimethylsilyl iodide, and amine, to obtain the final product a compound of formula (I), see columns 21-22 of Courtin et al. '429.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1626

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

“Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the

Art Unit: 1626

product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Also see M.P.E.P. 2113.

10. Claims 1-16 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtin et al. WO 99/29716 or US 6,677,429.

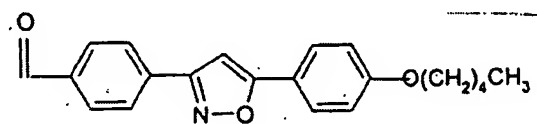
Applicants claim a compound of formula (I) as agents for treating fungal infection, and the compounds are found on the page 1-17 of the specification.

**Determination of the scope and content of the prior art (MPEP §2141.01)**

Courtin et al. disclose a compound of formula (I) as agent treating fungal infection. A number of examples have specifically exemplified, see columns 1-6 and 10-16 of Courtin et al. '429.

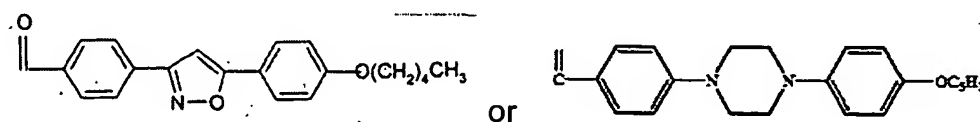
**Determination of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between the instant claims and Courtin et al. is that the instant variable R of formula (I) represents



, while Courtin et al. represents

at least one acyl containing heterocycle, i.e.,

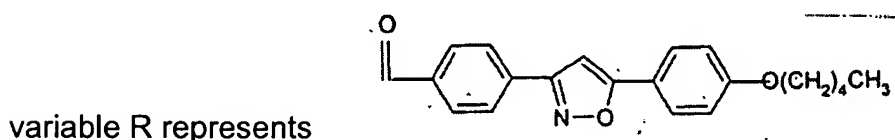


Art Unit: 1626

see columns 3-4 of Courtin et al. '429.

**Finding of prima facie obviousness-rational and motivation (MPEP §2142-2143)**

One having ordinary skill in the art would find the claims 1-16 and 20-23 facie because one would be motivated to employ the compounds of Courtin et al. to obtain instant compounds of formula (I), wherein the variables  $R_3$ ,  $R_4$ , T, W, Y, and Z independently represents hydrogen, alkyl, cycloalkyl, hydroxy, and the



The motivation to make the claimed compounds derives from the expectation that the instant claimed compounds would possess similar activities, i.e., treating fungal infection, from the known Courtin et al. compounds to that which is claimed in the reference.

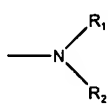
11. Claims 1-16 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtin et al. WO 99/29716 or US 6,677,429.

Applicants claim (i.e., claims 14-16 and 21) a process of preparing a compound of formula (I) using starting materials compounds of formula (II), (III), (IV), trimethylsilyl iodide, and amine, and the processes are found on the page 1-17 of the specification.

Art Unit: 1626

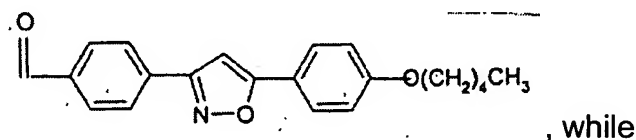
**Determination of the scop and content of the prior art (MPEP §2141.01)**

Courtin et al. disclose a process of preparing a compound of formula (I) comprising steps (i) a compound of formula (III) reacts with an agent capable of replacing  $\text{-NH}_2$  by  $\text{-NHR}$ , to obtain a compound of formula (IV); (ii) a compound of formula (IV) reacts with trimethylsilyl iodide to obtain a compound of formula (II); (iii) a compound of formula (II) reacts with amine or an amine derivative in

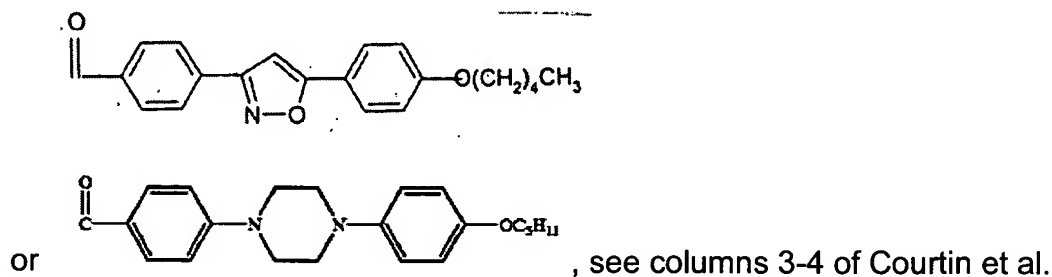
the presence of a reducing agent to induce  to obtain a compound of formula (I), see columns 21-22 of Courtin et al. '429.

**Determination of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between the instant claims and Courtin et al. is that the instant variable R of formula (I) represents



Courtin et al. represents at least one acyl containing heterocycle, i. e.,



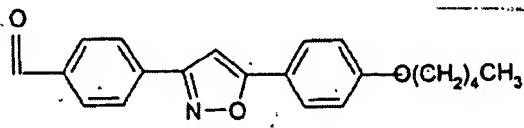
'429.



Art Unit: 1626

**Finding of prima facie obviousness-rational and motivation (MPEP §2142-2143)**

One having ordinary skill in the art would find the claims 1-16 and 20-23 facie because one would be motivated to employ the processes of Courtin et al. to obtain instant processes of preparing compounds of formula (I), wherein the variables R<sub>3</sub>, R<sub>4</sub>, T, W, Y, and Z independently represents hydrogen, hydroxy, alkyl, or cycloalkyl, and the

variable R represents , and starting materials compounds of formula (II), (III), and (IV) are used.

The motivation to make the claimed compounds derives from the expectation that the instant claimed processess would possess similar yields, from the known Courtin et al. processes using similar starting materials to that which is claimed in the reference.

***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164

Art Unit: 1626

USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claim 21 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28 and 33 of Courtin et al. copending Application No. 10/666,072. Although the conflicting claims are not identical, they are not patentably distinct from each other and reasons are as follows.

Applicants claim a compound of formula (III) or (IV), wherein the variables R, R<sub>3</sub>, R<sub>4</sub>, T, W, Y, and Z are as defined in claim 1. The compounds are found on the page 9 of the specification.

Courtin et al. claim a compound of formula (III) (i.e., claim 28), wherein the variable T is hydrogen, Y is selected from the group consisting of hydrogen, -OH, halogen and -OSO<sub>2</sub>H, W is hydrogen, Z is hydrogen or methyl. Courtin et al. claim a compound of formula (IV) (i.e., claim 33), wherein the variable R is selected from the group consisting of alkyl and cycloalkyl of up to 30 carbon

Art Unit: 1626

atoms optionally containing at least one heteroatom selected from the group consisting of oxygen, sulfur and nitrogen, at least one heterocycle and acyl of up to 30 carbon atoms optionally containing at least one heteroatom selected from the group consisting of oxygen, sulfur and nitrogen and/or at least one heterocycle (i.e., oxazole or oxadiazole),  $R_3$  is selected from the group consisting of hydrogen, methyl and  $-OH$ ,  $R_4$  is hydrogen or  $-OH$ ,  $T$  is hydrogen,  $Y$  is selected from the group consisting of hydrogen,  $-OH$ , halogen and  $-OSO_3H$ ,  $W$  is hydrogen,  $Z$  is hydrogen or methyl.

The difference between the instant claims and Courtin et al. is that the instant variable  $W$  of formula (III) or (IV) represents hydrogen or  $-OH$ , while Courtin et al. represents hydrogen.

One having ordinary skill in the art would find the claim 21 facie because one would be motivated to employ the compounds of Courtin et al. to obtain instant compounds of formula (III), wherein the variables  $R_3$ ,  $R_4$ ,  $T$ ,  $W$ ,  $Y$ , and  $Z$  independently represents hydrogen, and obtain instant compounds of formula (IV), wherein the variable  $R$  represents at least one acyl containing heterocycle (i.e., oxazole or oxadiazole), and the variables  $R_3$ ,  $R_4$ ,  $T$ ,  $W$ ,  $Y$ , and  $Z$  independently represents hydrogen.

The motivation to make the claimed compounds derives from the expectation that the instant claimed compounds would possess similar activities or function, i.e., a starting materials for preparing the compound of formula (I), from the known Courtin et al. compounds to that which is claimed in the reference.

Art Unit: 1626

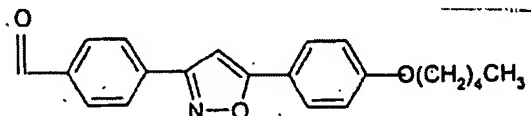
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-16 and 20-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 20 of Courtin et al. US 6,677,429. Although the conflicting claims are not identical, they are not patentably distinct from each other and reasons are as follows.

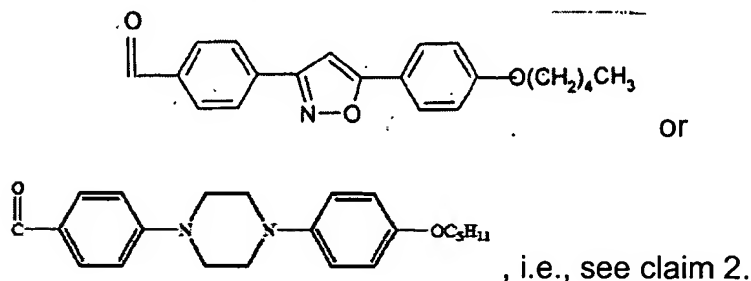
Applicants claim a compound of formula (I) as agents for treating fungal infection, and the compounds are found on the page 1-17 of the specification.

Courtin et al. claim a compound of formula (I) as agent treating fungal infection. A number of examples have specifically exemplified, see columns 10-16.

The difference between the instant claims and Courtin et al. is that the

instant variable R represents , while

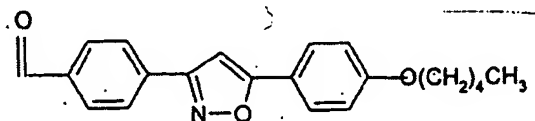
Courtin et al. represents at least one acyl containing heterocycle (i.e.,



One having ordinary skill in the art would find the claims 1-16 and 20-23 *facie* because one would be motivated to employ the compounds of Courtin et al.

Art Unit: 1626

to obtain instant compounds of formula (I), wherein the variables  $R_3$ ,  $R_4$ , T, W, Y, and Z independently represents hydrogen, and the variable R represents



The motivation to make the claimed compounds derives from the expectation that the instant claimed compounds would possess similar activities, i.e., treating fungal infection, from the known Courtin et al. compounds to that which is claimed in the reference.

### **Objection**

15. Claims 1-16, and 20-23 are objected to as containing non-elected subject matter heterocyclyl or heteroaryl, i.e., cycloalkyl of variables  $R_1$  or  $R_2$  optionally interrupted by oxygen, variables a and b form a heterocycle. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the pages 2-3 *supra*.

16. Claim 1, page 5, lines 3-4, recite the phrase "X is halogen and alk is alkyl of up to 8 carbon atoms", is objected. It appears there is a typographic error for the phrase. Replacement of the phrase "X is halogen and alk is alkyl of up to 8 carbon atoms" with the phrase "X is halogen or alkyl up to 8 carbon atoms", would obviate the objection.


Art Unit: 1626

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707.

The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

  
Rita Desai  
Primary Patent Examiner  
Technical Center 1600  
Tel: (571) 272-0684

1/6/05

January 04, 2005